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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

1400.4100291

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on 08-28-2006

Signature

Typed or printed name Ross D. Snyder, RegNo 37730

Application Number

09/625,586

Filed

07-26-2000

First Named Inventor

Jason T. Sterne et al.

Art Unit

2668

Examiner

Elallam, Ahmed

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

37,730

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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐

*Total of _____ forms are submitted.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Jason T. Sterne et al.

Title: MULTI-PROTOCOL SWITCH AND METHOD THEREFORE

App. No.: 09/625,586

Filed: 07-26-2000

Examiner: Elallam, Ahmed

Group Art Unit: 2668

Atty. Dkt. No. 1400.4100291

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Claims 1-34 are pending in the present application. The Examiner has rejected claims 1-34. Applicant respectfully requests reconsideration of pending claims 1-34. Applicant files herewith a notice of appeal. Pursuant to the "New Pre-Appeal Brief Conference Pilot Program," 1296 Off. Gaz. Pat. Office 67 (July 12, 2005) and the "Extension of the Pilot Pre-Appeal Brief Conference Program" dated 1/10/2006, Applicant submits a pre-appeal brief request for review. The review is requested for the reasons set forth below:

Applicant submits there exist clear errors in the Examiner's rejections and/or the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection. Applicant submits the Examiner's "Response to Arguments" provides evidence that the Examiner has failed to consider the pending claims as required by the Manual of Patent Examining Procedure (MPEP) and prevailing case law. For anticipation under 35 U.S.C. § 102, a reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present [emphasis added]. See MPEP 706.02 – distinction between 35 U.S.C. § 102 and § 103. As Applicant describes in detail below, Applicant submits there exist clear errors in the Examiner's rejections and/or the Examiner's omissions of one or more essential elements needed for a *prima facie* rejection.

Regarding claims 1, 2, 6, 7, 17, 22, 23, and 25, Applicant notes that Puntambekar et al. appear to teach away from the present invention. For example, in col. 5, lines 49-51, Puntambekar et al. state, "Egress means the Cell card that sends data cells upstream on the trunk, and "ingress" means the Cell card that receives data cells sent by an egress Cell card." Thus, for example, with regard to claim 1, Puntambekar et al. appear to teach

away from "...wherein the ingress line card forwards at least a portion of the cell over the switching fabric to at least one of the plurality of egress line cards based on the forwarding decision." As another example, with regard to claim 17, Puntambekar et al. appear to teach away from "receiving a cell over an ingress connection, wherein the cell includes an ingress connection identifier" and "...routing the cell through the multi-protocol switch based on the ingress connection identifier."

Applicant submits that, in the Examiner's Response to Arguments, the Examiner has misrepresented the teachings of Puntambekar et al. For example, the Examiner states, "As pointed out by the reference in column 5 lines 48-56, although the cards are being called 'ingress' and 'egress', the actual direction of the signal is irrelevant and so 'ingress' cards can also be considered 'egress' cards and vice versa since these terms delineate direction of traffic flow and traffic flows in both directions." In fact, column 5, lines 48-56, state as follows: "'Egress' means the Cell card that sends data cells upstream on the trunk, and 'ingress' means the Cell card that receives data cells sent by an egress Cell card. Note that this definition refers only to the direction of DATA flow for a particular MPT. The direction of signalling is irrelevant, as is the fact that a Cell card of one type with respect to a given MPT can also be a Cell card of the other type with respect to another MPT." Thus, the Examiner's assertions that "the actual direction of the signal is irrelevant" and "Thus each card is both an 'ingress' and 'egress' card" are inconsistent with the teachings of Puntambekar et al. with respect to a "MPT." Moreover, even if one were to assume that the Examiner's assertions were true (which Applicant disputes), Applicant submits that Puntambekar et al. still would appear to teach away from the present invention. For example, with regard to claim 1, Applicant submits Puntambekar et al. would still appear to teach away from "...wherein the ingress line card forwards at least a portion of the cell over the switching fabric to at least one of the plurality of egress line cards based on the forwarding decision." As another example, with regard to claim 17, Applicant submits that Puntambekar et al. would still appear to teach away from "receiving a cell over an ingress connection, wherein the cell includes an ingress connection identifier" and "...routing the cell through the multi-protocol switch based on the ingress connection identifier."

Furthermore, rather than teaching "a plurality of egress line cards..." and "an ingress line card..." "...wherein the ingress line card forwards at least a portion of the cell over the switching fabric to at least one of the plurality of egress line cards based on the forwarding decision," Puntambekar et al. states in col. 3, lines 9-11, "...multipoint-to-point (MPT) traffic destined for a switch is merged to a single virtual path...."

Applicant notes that claims 1, 2, 6, and 7 recite a "multi-protocol switch, comprising...a switching fabric operably coupled to the plurality of line cards; and an ingress line card operably coupled to the switching fabric...." Applicant submits that the recited structure is not disclosed in Figure 4 of Puntambekar et al. Rather, Figure 4 of Puntambekar et al. depicts several switches S10, S11, S20, and S21.

The Examiner has rejected all of claims 1-34 under either 35 U.S.C. § 102 or 35 U.S.C. § 103, citing what the Examiner apparently considers to be prior art. In the Examiner's Response to Arguments, the

Examiner states, "...Examiner respectfully disagrees, because the functions of the claimed "structure" are the same of the multi-protocol switching structure of that of Puntambekar as indicated in the rejection above."

Applicant submits the Examiner's position runs contrary to established Office procedure and underlying case law. Applicant has cited a portion of MPEP § 2114 that states, in part, "Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference." As the Examiner relies on the Examiner's assertion that "the functions of the claimed 'structure' are the same of the multi-protocol switching structure of that of Puntambekar as indicated in the rejection above," Applicant submits the rejection is improper.

Moreover, Applicant notes the Examiner stated, "(if the switch is to act as a leaf switch it forwards the cell by changing the VPI (see figure 4 and column 9 line 59 through column 10 line 26))." However, Applicant submits the Examiner has mischaracterized the teachings of the cited reference. For example, the only mention Applicant can find of "leaf" in the portion of the Puntambekar reference cited by the Examiner appears to be in column 10, lines 25 and 26, which merely states, "nor is it necessary for an intermediate switch to have been established as a leaf before a switch downstream of the intermediate switch becomes a leaf." However, Applicant notes column 9, lines 34-51, of the Puntambekar reference appears to discuss "a leaf switch," including column 9, lines 45-51, which state, "Thus the leaf switch determines the following from the destination address in the frame: (1) the MPT to send the data cells on to reach the destination (root) switch, and (2) the connection ID to be included with the data cells in order to reach the correct FE and Reassembly Identifier VC Entry RI on the destination switch." Thus, Applicant submits the alleged distinction the Examiner asserts with respect to "a leaf switch" and "a root switch" is not valid.

Regarding claims 1, 2, 6, 7, 17, 22, 23, 25, and 34, Applicant has presented argument above with respect to the Examiner's assertions regarding alleged teachings as to "a leaf switch" and "a root switch." Accordingly, Applicant submits the cited portions of the cited reference not only fail to disclose, but also teach away from, features recited "when the cell protocol is a first protocol" and "when the cell protocol is a second protocol" in the subject claims.

The Examiner makes assertions as to what would allegedly have been obvious to a person of ordinary skill in the art at the time of the invention. Applicant notes the Examiner cites no evidence upon which the Examiner supposedly bases such a conclusion. Applicant notes MPEP 2144.03 states, in part, "The standard of review applied to findings of fact is the 'substantial evidence' standard under the Administrative Procedure Act (APA). See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). See also MPEP § 1216.01. In light of recent Federal Circuit decisions as discussed below and the substantial evidence standard of review now applied to USPTO Board decisions...." Applicant submits the Examiner's assertion appears to lack a basis in "substantial evidence."

Regarding claims 3-5, Applicant submits Puntambekar et al. teach away, as noted with respect to base claim 1. Also, while the Examiner cites col. 1, lines 35-45 of Honda et al., Applicant notes that Honda et al. state, in col. 1, line 36, "...in the ATM router..." as the context for "reassembling" and "segmenting." Honda et al. then state, in col. 1, lines 43-45, "...two kinds of facilities, ATM routers and ATM switches, are required for constructing an ATM network." Thus, Applicant submits Honda et al. appear to describe "reassembling" and "segmenting" specifically in the context of "the ATM router," which Honda et al. appear to distinguish from "ATM switches." Thus, Applicant submits that there is no suggestion to combine the teachings of Honda et al. disclosed specifically in the context of "the ATM router" with the teachings of Puntambekar et al. so as to allegedly suggest the "multi-protocol switch" as set forth in claims 3-5.

Regarding claims 8-16, 18, 19, 24, 26, 27, and 33, Applicant submits Puntambekar et al. teach away, as noted with respect to the base claims and from any combination of references and prevent motivation to combine. Also, regarding claims 8, 12-16, 24, 26, 27, 9, 33, 10, 11, and 18, Applicant notes the Examiner acknowledges Puntambekar et al. do not disclose certain features. Regarding claims 31 and 32, to whatever extent the Examiner (but not necessarily Applicant) considers claims 31 and 32 to recited "similar limitations as that of claim 1," Applicant submits the teachings of Puntambekar not only teach away from claim 1 but also further teach away from any combination of the cited references and prevent motivation to combine.

Regarding claims 3-5, 8-12, 13-16, 18, 19, 24, 26, 27, and 31-33, in the Examiner's most recent Response to Arguments, the Examiner states, "Examiner respectfully disagree, as noted above Puntambekar is still believed to be a proper anticipating reference for the parent claims." Applicant submits the Examiner's statement provides no evidence the Examiner has considered the patentability of the dependent claims, including any additional features recited therein.

Regarding claims 20, 28, and 29, Applicant submits that Puntambekar et al. teach away from the present invention as set forth in claim 17, from which claim 20 depends. Also, as noted above with respect to Honda et al., Applicant submits that there is no suggestion to combine the teachings of Honda et al. disclosed specifically in the context of "the ATM router" with the teachings of Puntambekar et al. so as to allegedly suggest the "multi-protocol switch" as set forth in claims 28 and 29 or the "method for routing cell traffic using a multi-protocol switch" as set forth in claim 20. Furthermore, Applicant notes that the Examiner states that Puntambekar et al. do not disclose segmenting the reassembled packet to produce segmentation cells and forwarding segmentation cells. Furthermore, the Examiner states that Puntambekar et al. do not disclose that the ingress line card segments the reassembled packet to produce segmented cells.

Regarding claims 20, 28, and 29, in the Examiner's most recent Response to Arguments, the Examiner states, "...Examiner believes that a *prima facie* of obviousness is being established contrary to Applicants' assertion, because as shown above the claimed subject matter is shown to be unpatentable over Puntambekar, Honda et al., and Zheng et al. However, Applicant notes the Examiner's basis for believing the Examiner has

made a *prima facie* showing of obviousness appears to be entirely devoid of the criteria specified in MPEP § 706.02(j) and MPEP §§ 2143-2143.03. Thus, Applicant submits the Examiner has failed to establish a *prima facie* showing of obviousness.

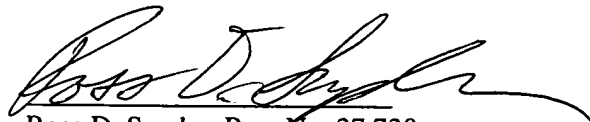
Regarding claims 21 and 30, Applicant submits Puntambekar et al. teach away, as noted with respect to base claims 17 and 28. Also, Applicant notes that the cited portion of Yang et al. states, "...the appropriate VPI/VCI destination address is retrieved from the output translation table 16 as illustrated in step 86 using the local CID as an index prior to transmission of the cell as illustrated in step 88." Thus, rather than teaching "determining an egress index for the reassembled packet based on the destination address," Yang et al. appear to teach away from such feature by appearing to teach "using the local CID as an index" to retrieve "the appropriate VPI/VCI destination address." Furthermore, Applicant notes that the Examiner states that Puntambekar et al. do not disclose determining an egress index for the reassembled packet based on the destination address and using the egress index to forward at least a portion of the reassembled packet to at least one egress connection. Also, with respect to claim 30, as noted above with respect to Honda et al., Applicant submits that there is no suggestion to combine the teachings of Honda et al. disclosed specifically in the context of "the ATM router" with the teachings of Puntambekar et al. so as to allegedly suggest the "multi-protocol switch" as set forth in claim 30.

Regarding claims 21 and 30, in the Examiner's most recent Response to Arguments, the Examiner states, "Examiner notes that the use of the local CID as an index read on the determination step and the use of such index in mapping the destination address (VPI/VCI) to retrieve the appropriate VPI/VCI destination address as the claimed using the egress index to forward at least a portion of the reassembled packet to at least one egress connection." Applicant submits the Examiner's statement reflects the Examiner's misinterpretation of the claims. Even within the Examiner's statement, the portion "...mapping the destination address (VPI/VCI) to retrieve the appropriate VPI/VCI destination address..." appears confused, either with respect to the cited reference, to the claim limitations, or to both.

Respectfully submitted,

08/28/2006

Date



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